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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,197	01/23/2004	Kristopher M. Krohn	8108	8090

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REINHART BOERNER VAN DEUREN S.C.  
ATTN: LINDA KASULKE, DOCKET COORDINATOR  
1000 NORTH WATER STREET  
SUITE 2100  
MILWAUKEE, WI 53202

EXAMINER
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MAI, TRI M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,197	<b>Applicant(s)</b> KROHN, KRISTOPHER M.	
	<b>Examiner</b> Tri M. Mai	<b>Art Unit</b> 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. The drawings filed 09/01/05 have been disapproved. The drawings provide specificities to the case with respect to the specific locations of these handles and wheels. The specificities with respect to the size of the wheels in Fig. 7B also add new matter to the application.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wheel rotatably secured to the back and front, the handle attach to the back and front of the enclosure must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The claims set for the pocket being adjustable. However, there is no structure that would enable this functionality.

Regarding claims 7 and 8, in view of the disapproval of the drawings, the recitation with respect to the wheels/handle being attach at least one of the various places renders the claim indefinite since the disclosure only show the wheels/handle being attach to only one place. See drawing objection.

4. Claim 1-3, 8, 10-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Krulik (5788032). Krulik teaches a luggage having an enclosure, an adjustable closed end pocket, the pocket being expandable, note figure 4 wherein pocket 30-1 is expanded from a closed position to an expandable position as claimed.

5. Claims 1, 2, 4-6, 12, 14, 18, 19, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (6547114). Smith teaches an enclosure, an adjustable closed end pocket, and the pocket being expandable via the strap portion 36 as claimed. With respect to the pocket being nonremovable. It is noted that the pocket in Smith is nonremovable as claimed, i.e., one can leave the pocket in place permanently.

Regarding claim 2, the fastening mechanism 36 can adjust the pocket from a collapse position as claimed.

It is noted that the pocket 60 is flexible to be collapsible as claimed. There is no structure to distinguish the claims from the pocket 30 in Smith. Furthermore, it is adjustable by the strap 36. Furthermore, the strap 36 can be adjusted to collapse the pocket.

6. Claims 1, 2, 4-8, 10-12, 14-19, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovett (20040011840) in view of Smith (6547114). Lovett teaches a luggage having a closed ended pocket as shown in Fig. 7. It would have been obvious to one of ordinary skill in the art to provide the adjusting strap 36 in Lovett '840 as taught by Smith to enable one to tighten the pocket for theissy bars.

Regarding claims 4, and 14, it would have been obvious to one of ordinary skill in the art to provide an adjustable strap 90 as taught by Smith to provide added security.

7. Claims 1-8, and 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovett '840. Lovette '840 teaches a motorcycle luggage with a pocket with two adjustable zippers on two sides. Lovette '840 meets all claimed limitations except for the closed end pocket. Fig. 7 teaches that it is known in the art to provide a closed ended pocket. It would have been obvious to one of ordinary skill in the art to provide a closed ended pocket in Fig. 1 to enable one to provide better support.

In the alternative, it would have been obvious to one of ordinary skill in the art to provide the zipper of Fig. 3 in the pocket of Fig. 7 to enable one to adjust the pocket easily.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Lovett '840 as set forth in paragraph 6 and 7, and further in view of O'Shea et al. (5782325). It would have been obvious to one of ordinary skill in the art to provide a retractable handle with a handle seat

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on the top of the enclosure in Lovett '840 as taught by O'Shea to provide an alternative retractable handle.

9. Claims 1-3, 8, 10, 12, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Guenther et al. (2316328). Guenther teaches a luggage having a adjustable pocket as shown in Figs. 3 and 6. The intended use recitation with respect to the luggage being used with a motorcycle does not impart any structure over the luggage in Guenther.

10. Claims 1-5, 8, 10, 12-15, 18, 19, 23, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Godshaw et al. (6109402). Godshaw teaches a removable luggage with a closed end pocket (note that portion 64 can be closed by the zipper 66) and the pocket is adjustable via the zipper and straps 78.

11. Claims 11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godshaw in view of Lovett '292. It would have been obvious to one of ordinary skill in the art to provide the rain cover as taught by Lovett to provide the luggage.

12. Applicant's arguments with respect to the claims have been considered they are not persuasive.

With respect to the Smith reference, as set forth above, the pocket in Smith is nonremovable as claimed, i.e., one can leave the pocket in place permanently. There is no structure to impart any differences over the pocket in Smith.

With respect to the rejection of Lovett '840 or Lovett'840 in view of Smith, as set forth above, it would have been obvious to one of ordinary skill in the art to provide the adjusting strap 36 in Lovett '840 as taught by Smith to enable one to tighten the pocket for the sissy bars.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, it would have been obvious to one of ordinary skill in the art to provide a closed ended pocket in Fig. 1 of Lovett '840 to enable one to provide better support, as taught by Fig. 7.

In the alternative, it would have been obvious to one of ordinary skill in the art to provide the zipper of Fig. 3 in the pocket of Fig. 7 to enable one to adjust the pocket easily.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571)272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai  
Primary Examiner  
Art Unit 3727

